REMARKS/ARGUMENTS

This communication is in response to the Office Action mailed September 19, 2005. Applicant respectfully submits that the obviousness rejections in the Office Action are improper and should be withdrawn.

It is noted that the "Status" box 2a) on the Office Action Summary sheet indicates "This action is FINAL." but this inconsistent with both the substance of the Office Action and with the docket listing for the Office Action on PAIR. Therefore, Applicant is treating this Office Action as a non-final Office Action.

Summary of Claimed Subject Matter Recited in Claim 1

Applicant has presented this summary previously.

Applicant's present claim 1 is directed to a method of dynamically checking a set of one or resource controls associated with resource consumption of newly added software to an **operating system**. While the operating system is executing, **resource controls** associated with the newly-added operating system software are integrated into resource controls already associated with the operating system software (before addition of the newly-added operating system software). The resource controls have limiting values associated therewith.

In response to a request for one of the resources by an operating system entity, it is determined whether usage of the one resources exceeds one of the limiting values for the resource controls. The request is granted if the limiting value has not been exceeded.

The Rejection

All of the pending claims are rejected as obvious over Holiday in view of Koved.

The Examiner Mischaracterizes the Primary Reference (Holiday)

The Examiner contends, in part, that Holiday discloses a method of, while an operating system is executing, integrating resource controls associated with the newly added operating system software into a set of one or more resource controls already associated with the operating system before addition of the newly added operating system software. See ¶4 at page 2 of the Office Action.

As alleged support for this contention, the Examiner cites to a number of different sections of Holiday. As discussed below, it is respectfully submitted that none of these sections actually supports the Examiner's contention.

Looking first at the Abstract, it can be seen that the Holiday disclosure is summarized there in part as

> The invention includes a patch environment for a modifying a program executed by a Java Virtual Machine ("JVM") while the program is being executed. The patch environment has a patch data structure defined on an electronic memory of the computer. The patch data structure has at least one Java patch for modifying a loader environment of the JVM.

The Examiner's statement of the rejection is ambiguous, as it is not entirely evident what elements disclosed by Holiday are considered by the Examiner to be the elements recited in the claims. With regard to the "newly added operating system software," clearly, the "program executed by a Java Virtual Machine" is not "operating system software." Perhaps the Examiner considers the JVM as the "operating system software" and the modified "loader environment of the JVM" as the "newly added operating system software."

If this is the Examiner's contention, this is clearly inapposite to the disclosure of Holiday. More specifically, especially as considered by Holiday, the JVM is not "operating system software." For example, a portion of the Holiday disclosure cited by the Examiner at col. 3 explicitly distinguishes the JVM from "operating system software."

Referring to Holiday's col. 3, lines 7-14, Holiday states:

> The operating systems, which are programs responsible for controlling the allocation and usage of hardware resources such as memory, central processing unit ("CPU") time, disk space, and peripheral devices, come in numerous varieties such as Unix, Windows 98, Windows NT for PCs and PowerPC Macintosh. Java programs can run on any of these operating systems.

By contrast, as stated by Holiday at col. 3, lines 15-17:

> The JVM has a clear mission: to run one Java application. When a Java application starts, a runtime instance is spawned. Each Java application runs inside its own JVM.

Certainly, the Examiner cannot contend that the JVM (which has the clear mission "to run one Java application") is operating system software (which "controls the allocation and usage of hardware resources").

For this reason alone, the Examiner's reliance on Holiday is seriously misplaced, and the rejection must fail.

Furthermore, even if the JVM (including the "loading environment") could be considered "operating system software," contrary to the Examiner's contentions, there is nothing in the cited portions of Holiday that discloses "integrating resource controls associated with the newly added operating system software into a set of one or more resource controls already associated with the operating system before addition of the newly added operating system software." That is, while the cited portions of Holiday disclose changing the loading environment of the JVM, none of these cited portions disclose "resource controls" at all, let alone "integrating" resource controls. This is apparently not coincidental, given Holiday's disclosure that it is "operating systems," and not the JVM or Java application, that are "responsible for controlling the allocation and usage of hardware resources ..." (col. 3, lines 8-9, cited above).

In sum with respect to Holiday, the Examiner's citation of Holiday is misplaced since the cited portions of Holiday do not disclose either newly added operating system software or integrating resource controls.

The Examiner Mischaracterizes the Secondary Reference (Koved)

The Koved reference is relied upon by the Examiner for its alleged teaching of "in response to a request for one of the resources by an operating system entity determining whether usage of the a one of the one or more resources by the operating system entity exceeds a one of the limiting values in the one of the set resource controls corresponding to the one of the resources." Of the various portions of Koved cited by the Examiner, the seemingly most relevant cited portion appears to be Figure 10b.

Figure 10b discloses, at step 1020, "Check resource limits," which the Examiner seems to have seized upon as disclosing "determining whether usage of the one or more resources by the operating system entity" exceeds a limiting value (emphasis added). Unfortunately, the "Check resource limits" step in Figure 10b is not performed by an operating system entity as the Examiner contends. Rather, this step is performed by a "Content Usage System." See col. 8, lines 28-55.

A "Content Usage System' is not, and does not include, an operating system entity. Similar to Holiday disclosure, as disclosed at col. 4, lines 16-61 of Koved, "The Operating Environment 140 may be an operating system, such as IBM's OS/2, MVS, Microware's

OS/9000, PC-DOS, Unix, Microsoft Windows NT or CE, and Sun's JavaOS. In a preferred embodiment, the Content Usage System 150 is typified by a Java Virtual Machine, and World Wide Web browsers." Furthermore, as Koved discloses at col. 4, lines 28-31 (emphasis added), "The Content Usage System 150, running in cooperation with the Operating Environment 140, is able to receive Content Descriptions 110 via the Operating Environment 140." The Content Usage System 150, running in cooperation with the operating environment, is distinct from the Operating Environment.

In summary, then, the Examiner's reliance on Koved is misplaced at least since the step of checking resource limits is relative to an entity that is not an operating system entity.

Motivation for Combination is not Sufficient for a Prima Facie Case of Obviousness

As with the previous obviousness rejections, the current obviousness rejection is similarly flawed. In particular, the Examiner has not stated a proper motivation for combining Holiday and Koved.

Identical to before, the Examiner's stated motivation for combining the references is, generically (replacing the former primary reference with "Holiday" and replacing the former secondary reference with "Koved"), "Holiday's method of assigning and comparing load values to resources would improve Koved's system of distributing different resources by being able to tell which resource has exceeded its predetermined threshold value."

In the first place, the Examiner has not even stated what are the "different resources" that are allegedly distributed by the Holiday disclosure. Furthermore, the Examiner points to nothing in either Holiday or Koved, or knowledge held by one of ordinary skill in the art, that suggests Koved's method would improve Holiday's system. This is required by MPEP 2143.01. The "teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure." See MPEP 2143.

A bald, unsupported assertion that the teachings of a secondary reference "would improve" the teachings of a primary reference are insufficient. The Examiner has not pointed to anything in the references or in knowledge held by one of ordinary skill in the art regarding the alleged improvement, including a reasonable expectation of success. The Examiner must be relying on the impermissible hindsight gleaned from Applicant's disclosure, and the obviousness rejection is insufficient for this reason, too.

CONCLUSION

For at least the reasons stated above, then, the Examiner has not made a proper prima facie case that the combination of Holiday and Koved in fact yields the subject matter recited in claim 1. Applicant's arguments similarly apply to the remaining independent claims. Furthermore, because the rejections of the dependent claims are premised on the propriety of the rejection of claim 1, the rejections of the dependent claims are similarly improper.

Applicant thus respectfully requests that the rejections of the claims be withdrawn, and Applicant respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at (650) 314-5324.

Respectfully submitted,

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